

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of: VIAL, S.

Serial No: 09/889,535

Examiner: Huynh, K.

Filing Date: January 16, 2002

Group Art Unit: 3751

For: WRITING INSTRUMENT WITH VARIABLY INCLINABLE TIP

Conf. No.: 4319

PETITION TO WITHDRAW FROM ISSUE, 37 C.F.R. §1.313(c)(2)

Mail Stop 313(c)

Office of Petitions

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant petitions under 37 C.F.R. §1.313(c)(2) to withdraw the application from issue in favor of a Request for Continued Examination (RCE) that is filed concurrently with this Petition together with a Preliminary Amendment.

The required petition fee is submitted herewith, together with an RCE transmittal form and the fees required for requesting continued examination.

The Rule 1.312 amendment was declined entry shortly before the issue fee due date. Applicant has paid the issue fee, and submitted Form PTOL-85 on October 11, 2006.

Applicant petitions for withdrawal of the application from issue to obtain consideration of the changes to the claims that were attempted in the amendment under Rule 1.312.

37 C.F.R. §1.313(a) provides that applicant may petition for withdrawal upon submission of the required petition fee (37 C.F.R. §1.17(h)) and a showing of good and sufficient reasons why withdrawal from issue is necessary. Applicant has submitted petition fee. The Commissioner for Patents also is hereby authorized to charge any underpayment or credit any overpayment to Deposit Account 04-1679.

Good and sufficient reason for withdrawal from issue is found in the fact that the claims that otherwise will be granted in the impending patent are not the claims that

applicant presented by amendment and sought to be examined. As further described in the concurrently filed preliminary amendment, withdrawal from issue is necessary to obtain correct entry and examination of the claims that applicant sought to present for examination in a response filed May 15, 2006. The amended claims therein contained underscores representing insertions of terms and strikeouts representing deletions of terms. In an official action dated May 24, 2006, the response was considered "noncompliant" as filed. The noncompliance was due to new drawings sheets being labeled "substitute sheet" instead of "replacement sheet." Claims that were no longer pending as a result of cancellation in an earlier amendment had not specifically been listed as canceled claims.

Applicant re-filed the response of May 25, 2006 on June 26th, making the corrections required by the Legal Instruments Examiner. When re-filing the response, including generating a new pdf document and filing it by EFS, the "strikeout" font formatting in the claims appears inadvertently to be removed and replaced with plain text formatting in the claims portion of the amendment.

The examiner recognized when considering the response that the claims contained extraneous informal or ungrammatical words. In consultation with applicant, a number of these terms were corrected by examiner's amendment. It was not realized at that time that something was amiss. Subsequently, applicant realized that the source of the error had been the lack of correct strikeout formatting of the compliant version of the response filed June 26, 2006, which had ostensibly only corrected the matters to which the PTO objected in the amendment of May 15, 2006.

In the meanwhile, the claims were allowed. Applicant sought to eliminate the remaining strikeout-formatted phrases in the claims by filing an amendment under 37 C.F.R. §1.312 on September 29, 2006. The amendment was refused entry on October 6, 2006. Applicant did not learn until after the issue fee due date that the Rule 312 amendment would not be entered. Applicant paid the issue fee and submitted the issue fee form PTOL-85, expecting that the Rule 312 amendment would be entered.

In refusing to enter the amendment under Rule 1.312, the examiner stated that the requested amendments to the claims would appreciably change the scope of the claims. Applicant believes that such amended claims are allowable over the prior art of

record. At this point in the proceedings, the only option that will obtain examination of the correctly amended claims is by way of continuation or RCE. Applicant proposes to withdraw the application from issue for consideration of the amended claims in an RCE.

For these reasons, withdrawal from issue is necessary.

All requirements for a grantable petition, including this petition, a showing of necessity, the required fee and the supporting RCE and preliminary amendment are attached. Applicant requests prompt consideration and grant of this petition, withdrawal from issue and continued examination in accordance with the claims in the preliminary amendment.

Should any further requirements be made, applicant requests notice to the undersigned attorneys by telephone.

Respectfully submitted,

Date: October 31, 2006

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